

REMARKS

This is intended as a full and complete response to the Final Office Action dated May 21, 2008, having a shortened statutory period for response set to expire on August 21, 2008. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-15 and 33-43 are pending in the application. Claims 1-15 and 33-43 remain pending following entry of this response.

Claim Rejections - 35 U.S.C. § 102

Claims 1-15 and 33-36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Henson (US 6,167,383, hereinafter "*Henson*").

Applicant respectfully traverses this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Independent Claims 1 and 9

In this case, *Henson* does not disclose "each and every element as set forth in the claim". For example, *Henson* does not disclose a computer-implemented method of cross-selling products based on a system for sale to a customer that includes *presenting the one or more cross-sell products to the user, wherein each of the one or more cross-sell products presented to the user is offered at a discount based on the*

state of the system, and wherein each of the one or more cross-sell products presented to the user is determined to be compatible with the state of the system, as recited in claim 1. Claim 9 includes a similar limitation. Regarding this limitation, the Examiner argues:

Henson explicitly discloses offering the user "McAfee VirusScan 3.1 at no additional charge" when the user has selected Microsoft Windows 95 or 98. (Figure 3a). Thus, Henson is offering a cross-sell "at a discount based on the state of the system", but only when it "is determined to be compatible with the state of the system", i.e. only when the user has selected Microsoft Windows 95 or 98.

Final Office Action, page 3. In other words, the Examiner is arguing that a selection box for "McAfee VirusScan 3.1" shown in Figure 3A of *Henson* teaches the recited limitation.

Applicant respectfully submits that the Examiner's analysis is flawed. The cited selection box of Figure 3A is not discussed or explained in the text of *Henson*. Thus, there is no indication that the McAfee software is being offered "at a discount based on the state of the system," as assumed by the Examiner. For example, it may also be assumed that such software is free regardless of the vendor (i.e., "freeware"), or that such software is included for free with all computer orders. Further, Applicant submits that the present claims recite *cross-sell products...offered at a discount*, and not offered "at no additional charge." That is, a discounted product is not equivalent to a free product. Thus, *Henson* does not teach that the *one or more cross-sell products presented to the user is offered at a discount based on the state of the system*.

Applicant further submits that the cited material does not teach that *each of the one or more cross-sell products presented to the user is determined to be compatible with the state of the system*. The Examiner argues that Figure 3A of *Henson* teaches that the McAfee software is offered "only when the user has selected Microsoft Windows 95 or 98," and thus the "discount" is based on the state of the system. However, *Henson* does not disclose that the choices included in the cited selection box of Figure 3A are in anyway determined to be compatible with the state of the system

(i.e., to a particular OS), as assumed by the Examiner. For example, it may also be assumed that the selection box includes multiple software choices, each corresponding to a different OS, with the selection of the proper software being left to the user. Thus, *Henson* does not teach that the *cross-sell products presented to the user is determined to be compatible with the state of the system*.

Independent Claim 33

In the Final Office Action dated May 21, 2008, the Examiner argues that claim 33 is taught by *Henson*. Regarding the third clause of claim 33, the Examiner states:

c. determining a discounted value for each of the cross-sell products (inherent);

Final Office Action, page 5. However, the third clause of claim 33 actually states:

determining, based on the user selections of one or more component products, a discounted value for each of the one or more cross-sell products;

Applicant respectfully submits that omitting the underlined limitation has the effect of mischaracterizing claim 33, and thus trivializes the claim limitation. Therefore, Applicant submits that the Examiner has failed to properly establish the rejection of claim 33.

Further, the Examiner argues that the limitation of *determining, based on the user selections of one or more component products, a discounted value for each of the one or more cross-sell products* is inherent. Applicant respectfully submits that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). See MPEP Sec. 2112. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a

given set of circumstances is not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). *See id.* Since determining a discounted value for each of the cross-sell products is not necessarily present in the configuration screen of *Henson*, it is not an inherent feature of *Henson*. Thus, *Henson* does not disclose *determining, based on the user selections of one or more component products, a discounted value for each of the one or more cross-sell products.*

The Examiner also argues that the limitation of *providing, based on the user selections of one or more component products and the user selection of at least one cross-sell product, one or more software wizards to assist the user in configuring the configured system* is taught by the "configuration, pricing, validation, shipment delay indication, and merchandising modules" described in *Henson*, column 6, lines 31-34. Applicant respectfully submits that the claim term "software wizard" refers to a user interface configured to aid a user in performing a defined task. For example, see the software wizard illustrated in Figure 5 of the present application. In contrast, the cited "modules" of *Henson* are not described as software wizards, but rather are described as software components of an "on-line store application." Thus, *Henson* does not disclose *one or more software wizards to assist the user in configuring the configured system.*

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 37-43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Henson* (US 6,167,383).

Applicant respectfully traverses this rejection.

The Examiner bears the initial burden of establishing a prima facie case of obviousness. See MPEP § 2141. Establishing a prima facie case of obviousness

begins with first resolving the factual inquiries of *Graham v. John Deere Co.* 383 U.S. 1 (1966). The factual inquiries are as follows:

- (A) determining the scope and content of the prior art;
- (B) ascertaining the differences between the claimed invention and the prior art;
- (C) resolving the level of ordinary skill in the art; and
- (D) considering any objective indicia of nonobviousness.

Once the *Graham* factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art.

Further, the Federal Circuit points out that in *KSR International Co. vs. Teleflex, Inc.*, 127 S. Ct. 1727 (2007) the Supreme Court “acknowledged the importance of identifying ‘a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does’ in an obviousness determination.” *Takeda Chemical Industries, Ltd. v. Alphaphram Pty, Ltd.*, 492 F.3d 1350, 1356 (Fed. Cir. 2007).

Regarding the rejection of independent claim 37, the Examiner states:

While Henson does not explicitly disclose receiving a second configured system based on a previous order from the same user, it is disclosed that the user may be an individual, a business (small, medium, or large), or a government employee (Figure 8) and it is also disclosed the system asks if the user is a previous customer (Figure 7). The Examiner also notes that compatibility with legacy systems is always a main concern to businesses looking to upgrade or expand their existing systems. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Henson to check the compatibility of the component of the new system to each other, but also the compatibility of the components (and the whole system) with one or more previously ordered systems. One would have been motivated to do such a compatibility check between the systems in order to allow businesses to integrate the new system with their legacy systems. Additionally, if it is determined that the two systems are not compatible (e.g. old

Mac system vs new PC system), such a determination may provide the opportunity for the merchant to present an offer to the user for additional software or hardware, such as a MAC to PAC converter

Final Office Action, pages 7-8. The Applicants respectfully submit that the Examiner's reasoning for finding claim 37 to be obvious is merely a conclusory statement (*i.e.*, "it would have been obvious to one having ordinary skill in the art at the time the invention was made for Henson to check the compatibility of the component of the new system to each other, but also the compatibility of the components (and the whole system) with one or more previously ordered systems"), and fails to articulate reasons for a finding of obviousness with sufficient particularity. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness". *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); cited with approval in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41 (2007). That is, even if we assume, *arguendo*, that one of skill in the art "would have been motivated to do such a compatibility check between the systems in order to allow businesses to integrate the new system with their legacy systems," the Examiner fails to explain why one would do so in the specific manner recited in the present claims. For example, the Examiner argues that *Henson* discloses that "the system asks if the user is a previous customer (Figure 7)" (*Final Office Action*, page 7). However, *Henson* does not disclose that an earlier system order placed by the customer is then retrieved, or that there is any sort of checking for cross-sell products that are compatible with both a current system order and the earlier system order, as required by the Examiner's argument. In fact, *Henson* does not disclose any sort of storage of earlier system orders at all, or of any need for compatibility across orders. Therefore, the Examiner has not provided a *prima facie* case of obviousness as required by MPEP § 2143.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

If the Examiner believes any issues remain that prevent this application from going to issue, the Examiner is strongly encouraged to contact Gero McClellan, attorney of record, at (336) 643-3065, to discuss strategies for moving prosecution forward toward allowance.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

/Gero G. McClellan, Reg. No. 44,227/

Gero G. McClellan
Registration No. 44,227
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicants